

Application No. 09/940,665
Response dated June 25, 2004
Reply to Office Action of February 25, 2004

REMARKS

Claims 1-7, 20, 22 and 24 are pending in this application, of which claim 1 has been amended. Claims 8-19, 21, 23 and 25 have been canceled.

(1) Applicants were requested to cancel non-elected claims 8-19, 21, 23 and 25. In this response, Applicants has canceled these claims, withholding the right to file a divisional application therefor.

(2) Claims 1-7, 20, 22 and 24 were rejected under 35USC§112, first paragraph, because of the monomer compound, which was incorporated by the previous amendment, is not supported by the specification. Office Action, page 4, section 11.

Also, claim 3 was rejected under 35USC§112, second paragraph, because the structures defined in claim 3 are inconsistent with the claim limitation of the monomer compound in claim 1. Office Action, page 4, section 13.

Claim 1 has been amended, whose basis is found at original claim 1. Claim 1, as amended, is supported by the specification, and then, the structures recited in claim 3 meet the limitation of claim 1. Reconsideration of the rejections of claims 1 and 3 under 35USC§112 is respectfully

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requested.

(3) Claims 1-2, 4-5, 20, 22 and 24 were rejected under 35USC§102(b) as being anticipated by Nagata et al. (US 5,856,561). Office Action, pages 5-6, section 16.

Applicants traverse the rejection because Nagata et al. do not disclose any resist composition including a compound having the **combination** of an acetal moiety and a site which is eliminated by an acid in its molecule. The office action asserts that the first monomer of polymer 3 of Nagata et al. meets the limitation of the claimed "compound," because $\text{-CHCH}_3\text{-O-CH}_2\text{CH}_3\text{-}$ meets the limitation of both an acetal moiety and a site which is eliminated by an acid. However, polymer 3 of Nagata et al. does not include two groups, that is, the acetal moiety and the site which is eliminated by an acid. Therefore, polymer 3 of Nagata et al. does not correspond to the compound of the present invention. Namely, the compound recited in claim 1 has the combination of an acetal moiety and the site which is eliminated by an acid. The term "combination" means that the compound has, at least, the two groups in its molecule. Therefore, the rejection of claim 1 under 35USC§102(b) is not supported by Nagata et al. Reconsideration of the rejection is respectfully requested.

(4) Claims 1-7, 20, 22 and 24 were rejected under 35USC§103(a) as being unpatentable over Uetani et al. (US6,383,713). Office Action, page 7, section 18.

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Applicants traverse the rejection because Uetani et al. do not teach a resist composition further including "a compound having the combination of an acetal moiety and a site which is eliminated by an acid in its molecule." According to the teaching of Uetani et al. at col. 6, lines 18-48, the taught "acetal type esters" have to be reacted with the taught "acrylic monomers" in order to obtain a monomer, which is then copolymerized to become the taught "polymerization units." However, the monomer prepared by the teaching has only one group, that is, an acetal group or a group which is eliminated by an acid. The teaching of Uetani et al. do not produce the combination of the present invention. On the other hand, the monomer recited in claim 1 includes a **combination** of an acetal moiety and a site which is eliminated by an acid **in its molecule**. Therefore, the compound recited in claim 1 cannot be prepared according to the teaching of Uetani et al. Reconsideration of the rejection is respectfully requested.

(5) In view of the above, the pending claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

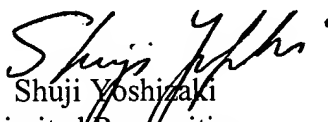
If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact the Limited Recognition, as attached, at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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Limited Recognition

Attachment: Limited Recognition

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